

Remarks

This Amendment is filed in response to the Office Action dated January 26, 2009. Applicants respectfully request reconsideration and allowance of the claims in light of the following remarks.

I. Restriction Requirement

The Office Action maintains the Restriction Requirement and has deemed the Restriction as final. While Applicants continue to disagree with the Restriction, according to the rules, Applicants previously made a provisional election directed to claims 2-6 and 8 in the last response. Under MPEP § 821, the Examiner has now withdrawn the provisionally non-elected claims from further examination. Applicants list the provisionally non-elected claims herein as withdrawn based on the designation of said claims by the Examiner as withdrawn in the current Office Action.

II. The Claims Are in Proper Form

The Office Action rejects claim 6 for lacking antecedent basis for the term "the selection." In response, Applicants have amended claim 6 to provide a proper antecedent basis. This amendment is not being presented for a reason related to patentability. To the contrary, one having ordinary skill in the art would have readily understood from the original version of claim 6 (even in the absence of an antecedent basis) what Applicants regard as the invention. The original version of claim 6 therefore satisfies the definiteness requirement of 35 U.S.C. 112, second paragraph. No disclaimer or estoppel is intended as a consequence of this amendment. Nor does this amendment add new matter to the claims.

III. Designation of the Office Action as Final is Improper

During prosecution of the present application, Applicants received an Office Action, dated September 11, 2007 ("First Office Action"), rejecting claims 1-13 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 7,062,722 issued to Carlin. Subsequently, Applicants responded to the First Office Action by placing dependent claim 6 in independent form. Following this submission, Applicants received the present Office Action, rejecting claims under 35 U.S.C. 103(a) as obvious over a different prior art reference, namely U.S. Patent No. 7,099,734 issued to Pieper.

The present Office Action has been designated as "Final." Applicants respectfully submit that the designation of the Office Action as Final is improper.

Under MPEP § 706.07(a), the "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims." Applicants respectfully submit that amendments made to the claims in response to the First Office Action should not have necessitated new grounds of rejection, as the amendments were made to merely place previous dependent claim 6 in independent form. To be more specific, no new matter or wording was added to claim 6 when converting it to an independent claim. The text of claim 1 was added directly to the existing wording of claim 6. Mere placement of the claim in independent form does not alter the scope of such claims. As such, the scope of claim 6 did not change when examined under the current Office Action. It is further noted that the current Office Action introduces a new ground of rejection based on previously presented and unamended claim language by rejecting the claims based on a newly cited reference. Under MPEP § 706.07(a), labeling of the current Office Action as "Final" is thus improper. As such, Applicants respectfully request that a new non-final Office Action be issued.

IV. "Capable of" Recitations in the Claims Should be Given Weight

The Office Action alleges that recitations beginning with the phrase "is capable of" in the claims are intended use and thus should not be given weight. Applicants respectfully disagree. The Office Action's stance relative to this language is not in line with the MPEP and Court rulings. For example, MPEP § 2173.05(g) specifically states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. . . .

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular

capability or purpose that is served by the recited element, ingredient or step.
(emphasis added).

In this regard, the claims of the present application use language such as “is capable of” to define various functional limitations of the processing element. Each of these recitations must be given weight in examination of the claims as the recitations act as functional limitations of the claims and define a particular capability or purpose that is served by the processing element.

V. The Claims are Patentable Over the Cited References

The Office Action rejects the claims as obvious over U.S. Patent No. 7,099,734 under 35 U.S.C. § 103(a). The ‘734 patent discloses a Computer Aided Design (CAD) method for product evaluation comprising a processing element and a graphical representation. The system disclosed in the ‘734 patent allows a garment designer to perform virtual tests on clothes designs to determine such aspects as wear and tear, fit, etc. The Office Action argues that the ‘734 patent’s method to design and evaluate a product is equivalent to a system for facilitating the selection of a purchasable item. Applicants disagree with these rejections.

Applicants first note that the ‘734 patent is nonanalogous art. Section I of MPEP § 2141.01(a) states that “to rely on a reference under 35 U.S.C. 103, it must be analogous prior art.” The ‘734 patent discloses a computer generated modeling of a single product in an environment for testing purposes. The present invention, however, relates to presenting products in an environment relating to retail sales. There is no disclosure in the ‘734 patent regarding display of purchasable items to a customer. There is no disclosure regarding allowing a user to select and view purchasable items. The ‘734 patent is directed to a specific function – providing a visual interface to a clothes designer to allow the designer to test a clothing design and materials intended for use with the clothing. It is not clear, and indeed, not logical that one skilled in the art seeking to provide a system that allows customers to select and view purchasable items would know to look to a reference disclosing a system related to testing of clothes design. As a result, Applicants respectfully submit that the ‘734 patent is nonanalogous art and is improperly used in rejecting the claims of the current application.

Applicants further submit that the ‘734 patent neither anticipates nor renders obvious the claimed invention. Independent claim 6 of the present invention claims “a processing element

capable of proposing a plurality of purchasable items to the customer for selection by the customer." The processing element is also capable of

[P]roposing a second set of purchasable items to the customer for selection by the customer, and wherein said processing element is further capable of filtering the first set of purchasable items based at least in part upon the at least one customer preference to generate the second set of purchasable items.

At least this aspect of the claimed invention is nowhere taught by the '734 patent. The only plausible place that the '734 patent mentions generation of a list of items is the discussion beginning at Col. 18, line 17, where the '734 patent discloses the process of redesigning product sub-models for testing. Here, the '734 patent describes adding to or adjusting the original product's features for further testing during the evaluation process but does not, at any point, teach or suggest either filtering the first set of items or the generation of a second set of items based on customer preference. It merely discloses modifying at least one sub-model characteristic of the originally tested product for further evaluation. The '734 patent does not teach the option to select specific sub-model modifications at any point. Further, the '734 patent does not even suggest generating a list of options based on user preference. The claimed invention clearly is not anticipated by the '734 patent.

Further, Applicants respectfully submit that the '734 patent does not suggest or make it obvious to try the above recitation of independent claim 6. The '734 patent would not lead one of ordinary skill in the art to the claimed invention because the '734 patent neither explicitly describes nor implicitly suggests the claimed generation of item sets. When confronted with the issue of product set generation in a virtual retail environment, one of skill in the art would not look, or even think to look, to clothes modeling and testing for guidance. The present invention specifically claims a retail environment where first and second sets of purchasable items are generated based on customer preference. The '734 patent does not teach such a system or anything comparable. The '734 patent does not describe the generation of sets of purchasable items, or filtering a first set of purchasable items to create a second set of purchasable items based on either a selection by a customer or a customer preference. It nowhere suggests such a problem of providing a filtered list of items to a customer or a solution to such problem. As such, in light of the above, Applicants respectfully submit that independent claim 6, as well as the claims that depend therefrom, are patentable over the cited reference.

Conclusion

In view of the pending claims and the remarks presented above, it is respectfully submitted that all of the present claims of the application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 13-4365.

Respectfully submitted,

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